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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,638	10/24/2003	Charlotte Famy	244625US0	7606

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EXAMINER

MARCANTONI, PAUL D

ART UNIT	-	PAPER NUMBER
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1755

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,638

Applicant(s)

FAMY ET AL

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/28/05 amdmnt and response.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-28 is/are pending in the application.
4a) Of the above claim(s) 27 and 28 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 9-26 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 9-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/28/05

- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

Applicant's arguments filed 2/28/05 have been fully considered but they are not persuasive. The applicants' amendment necessitated the new grounds of rejection below:

Non-Elected by Original Presentation:

Newly submitted claims 27-28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 27-28 are directed to non-elected Group III from the examiner's restriction requirement mailed 8/27/04. Applicants constructively elected Group I, claims 1-3 and 6 drawn to a panel (class 52/100+) in their 9/15/04 response. Group III was withdrawn from consideration because they are non-elected claims and applicants again present claims that are non-elected and withdrawn from consideration. Since applicant has received an action on the merits for the originally presented invention, this invention (Group I, claims 1-3 and 6) directed to a panel) has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP 821.03.

New Matter:

Claims 15-20 are rejected under the first paragraph of 35 USC 112 and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

Claims 15-17 are new matter because applicants do not have support for any or all types of cement but are limited by their original disclosure to Portland cement.

Applicants are referred to their own Example 2 on page 9 of their specification which teaches 40% calcium carbonate and 15% fly ash. The type of cement utilized must be Portland cement, and even more specifically, it must be in the amount of 39.7 wt%.

Claims 18-20 are new matter because they refer to Example 1 on pages 8-9 of applicants' specification. Again, Portland cement must be the cement used and applicants do not have support for any or all types of cement and thus these claims are new matter. The applicants also did not provide the critical amount of Portland cement of 34.7 wt% which they appear to be limited to as well.

35 USC 112 First Paragraph-Commensurate with Enabling Disclosure

Claims 9-26 are not commensurate with the applicants original enabling disclosure because original claim 4 and page 7 of the applicants specification have an upper limit and lower limit for the amount of fibers added to their flat panel composition. Are applicants saying they can added any or unlimited amounts of synthetic fiber from zero to 45 wt% (the highest amount permissible if you take the lowest values of wt% for cement and calcium carbonate)? Would this large amount of fibers (synthetic only) also cause problems in the Hatschek process?

35 USC 112 Second Paragraph:

Claims 9-26 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The applicants need the article –The—before Flat panel in all dependent claims.

The term "capable of" would appear indefinite and applicants can consider amending "capable of undergoing" to ---that undergoes----. It is not clear whether it actually undergoes a pozzolanic action or not so please provide definitive language and not the language of possibilities.

Claim 9 is indefinite because the original claims and original disclosure still appears to require from 2 to 10 wt% fibers. The applicants state at least some are synthetic fibers in this new claim but do not particularly point out and distinctly claim their invention. It would appear that there is a critical amount of cellulose fibers and synthetic fibers such as polyolefin fibers or polyvinyl alcohol fibers. It is the examiner's position that it was improper for applicants to split apart original claim 4 into two separate parts because all the amounts and components of that claim must be part of the same claim to be supported by the original claim. The applicants new claim 9 and 14 are now the result of splitting apart original claim 4 which appears to be also not commensurate with their original enabling disclosure as well.

Claims 15-17 and 18-20 are also indefinite because they do not particularly point out and distinctly claim the specific amounts of each component which applicants took from Examples 2 and 1 respectively. It would appear improper to split these amounts apart unless they claim the specific amounts of each example.

Claim 26 is improper and would appear indefinite because it appears applicants are claiming 4 different articles: Namely, a flat panel, siding, cladding element, and partition element. This is not proper because only a flat panel was constructively elected (Group I with traverse) for examination and not these other articles. Applicants may

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amend and correct by stating –The flat panel according to claim 9, wherein it is used as siding, a cladding element, or a partition element. Thus, applicants should amend their claim to indicate intended use to resolve these issues.

35 USC 103:

Claims 9-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. '775 or Merkley et al. '103 B2.

Response:

The applicants acknowledge that Johnson'775 or '159 both teach 40-80% Portland cement, synthetic fibers, and 10 to 40 wt% filler of which calcium carbonate is one. The applicants argue that ~~simply because~~ none of the examples contain the amounts as applicants claim for their invention. In rebuttal, as applicants are well aware, a reference is good for all that it realistically teaches and is not limited to the examples nor the preferred embodiments. Johnson teaches overlapping amounts of cement, fiber, and filler such as calcium carbonate and thus meets the applicants' claimed invention. It should be further noted, as seen by applicants new claim 9, that their claimed invention or claimed panel is not autoclaved. Yet, the decision to autoclave or use another known curing procedure would have been an obvious design choice for one of ordinary skill in the art. Johnson et al. '775 even teach in col.4, line 19 and col.11, lines 41-47 that they do not require autoclaving either.

The examiner has withdrawn most references except for those listed above because the withdrawn references from the original rejection all required autoclaving which is now a negative limitation of applicants' instantly claimed invention. The examiner also withdrew all Merkley patents with the exception of Merkley et al. '103 B2. Merkley et al. 103 teaches that they can use their product as a siding (ie a panel-see col.9 line 40) and even teach the formulation that is encompassing of the applicants' claimed invention (see col.9, lines 40-53) and which is inclusive of air curing. Merkley does not require that their composition must only be autoclaved but it appears it can be air cured as well.

Finally, Baes '672 was withdrawn from the rejection above only because it did not teach calcium carbonate in the amounts for the applicants' claimed invention. Baes '672 teaches 8-25% hydrated lime (not calcium carbonate but calcium hydroxide) and light filler which could be potentially calcium carbonate but not in the proper amounts because the highest amount added was only 20 wt% which is far short of applicants' lower limit for calcium carbonate of 35 wt%.

The finality of this office action is now proper and examiner has addressed all arguments presented by applicants' counsel. The applicants' amendment necessitated the new grounds of rejection above. **THIS ACTION IS MADE FINAL.** See also MPEP 706.07(a) Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed

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within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
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